

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **OTSUKI, Koichi, et al.**

ATTN: MAIL STOP PCT

Serial No.: **10/567,968**

Group Art Unit: **1615**

Filed: **February 10, 2006**

P.T.O. Confirmation No.: **7177**

For: **ANTIVIRAL AGENT, AND FABRIC AND ANTIVIRAL MEMBER
SUPPORTING ANTIVIRAL AGENT**

RENEWED PETITION UNDER 37 CFR 1.47(a)

Mail Stop PCT

Attn: Bryan Lin, PCT Legal Examiner

Commissioner for Patents

Office of PCT Legal Administration

P.O. Box 1450

Alexandria, VA 22313-1450

December 28, 2007

Dear Sir:

In response to the Decision on Papers Under 37 CFR 1.47(a) dated **June 29, 2007**, copy enclosed, submitted herewith for filing is a Declaration Regarding Non-Signing Inventor and an English Translation of a Complaint along with a letter addressed to the Tottori Police in Tottori Prefecture, Japan.

The previously submitted Petition stated that joint inventor Mr. Masami Yakura could not be found. In the Decision dated June 29, 2007, it was alleged that the Petition did not sufficiently demonstrate that a diligent effort must made to locate Mr. Yakura. Petitioner herein has supplied additional evidence in the form of the Declaration of Kazuo Wakabayashi, the complaint and a copy of the letter to the Tottori Prefecture Police regarding the relationship between Mr. Yakura and the application owner. In view of these documents, it is reasonable to conclude at the present time that a diligent effort was made to locate Mr. Yakura.

In the event that any fees are due with this paper, please charge Deposit Account No. 01-2340.

In the event that this response is not timely filed, the applicants hereby petition for an appropriate extension of time. The fees for any such extension may be charged to our Deposit Account No. 01-2340. Respectfully submitted,

KRATZ, QUINTOS & HANSON, LLP



Donald W. Hanson
Attorney for Applicants
Reg. No. 27,133

DWH/rmp

Atty. Docket No. **060131**
Suite 400
1420 K Street, N.W.
Washington, D.C. 20005
(202) 659-2930



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PATENT & TRADEMARK OFFICE

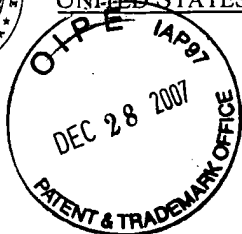
Enclosures: Decision Under 37 CFR 1.47(a); Declaration Regarding Non-Signing Inventor;
English Translation of a Complaint along with a letter address to Tottori
Prefecture Police



29 JUN 2007

DWH

UNITED STATES PATENT AND TRADEMARK OFFICE



COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP
1725 K STREET, NW
SUITE 1000
WASHINGTON, DC 20006

JUL 3 2007

2-months response
Due: AUGUST 29, 2007
REQUEST FOR RECONSIDERATION

In re Application of OTSUKI et al
U.S. Application No.: 10/567,968
PCT Application No.: PCT/JP2004/011853
Int. Filing Date: 10 August 2004
Priority Date Claimed: 12 August 2003
Attorney Docket No.: 060131
For: ANTIVIRAL AGENT AND FIBERS AND
ANTIVIRAL MEMBERS USING THE
SAME

DECISION

This is in response to applicant's "Renewed Submission Under 37 CFR 1.47(a)" filed 21 June 2007.

BACKGROUND

On 10 August 2004, applicant filed international application PCT/JP2004/011853, which claimed priority of an earlier Japan application filed 12 August 2003. A copy of the international application was communicated to the USPTO from the International Bureau on 17 February 2005. The thirty-month period for paying the basic national fee in the United States expired on 12 February 2006.

On 17 February 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 30 August 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 28 November 2006, applicant a petition under 37 CFR 1.47(a).

On 26 February 2007, this Office mailed a decision dismissing the 28 November 2006 petition.

DOCKETED

DATE

for file
7/6/07

On 12 April 2007, applicant filed a renewed petition under 37 CFR 1.47(a).

On 24 April 2007, this Office mailed a decision dismissing the 12 April 2007 petition.

On 21 June 2007, applicant filed the present second renewed petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

Applicant has previously satisfied items (1), (3) and (4) above.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

The petition states that joint inventor Masami Yakura cannot be found. However, the petition does not sufficiently demonstrate that a diligent effort was made to locate Yakura. Petitioner has supplied evidence (see affidavit of Kazuo Wakabayashi and copies of letters) of attempts to reach Yakura by a single method, i.e. postal mail. However, the petition does not establish that petitioner tried to reach Yakura by other methods, e.g. by telephone, by electronic mail, by searching public directories, and by contacting Yakura's former employer and co-workers. Thus, it would not be reasonable to conclude at the present time that a diligent effort was made to locate Yakura.

CONCLUSION

For the reasons above, the second renewed petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)".

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Bryan Lin
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
Facsimile: 571-273-0459



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Koichi OTSUKI et al

Group Art Unit: 1615

Serial No.: 10/567,968

Examiner: Not Yet Assigned

Filed: February 10, 2006

P.T.O. Confirmation: 7177

For: ANTIVIRAL AGENT, AND FABRIC AND ANTIVIRAL MEMBER SUPPORTING
ANTIVIRAL AGENT

DECLARATION REGARDING NON-SIGNING INVENTOR

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I, Kazuo WAKABAYASHI, declare that:

(1) I am a citizen of Japan and have the following address:

c/o Mochigase Electrical Equipment Co., Ltd.
7-2 Mochigase, Mochigase-cho, Yazu-gun
Tottori 689-1201, Japan

(2) The above-identified application is the U.S. national stage of the following
international application:

PCT/JP2004/11853
Filed August 10, 2004

The subject application claims priority from the following Japanese patent applications:

JP 2003-292073 Filed 8/12/2003
JP 2003-402529 Filed 12/2/2003

The application was filed in the U.S. without a Declaration.

(3) The proprietary interest in the invention which is the subject of the above-identified application belonged to the following juristic entity:

Mochigase Electrical Equipment Co., Ltd.
7-2 Mochigase, Mochigase-cho, Yazu-gun
Tottori 689-1201, Japan

(4) I am President of said Mochigase Electrical Equipment Co., Ltd. (hereinafter "Mochigase") and am authorized to sign on behalf of said Mochigase which has a proprietary interest in the subject application.

(5) By virtue of this proprietary interest, I signed the U.S. patent Declaration on behalf of, and as agent for non-signing inventor, Masami Yakura, a citizen of Japan and whose last known address was as follows:

c/o Mochigase Electrical Equipment Co., Ltd.
7-2 Mochigase, Mochigase-cho, Yazu-gun
Tottori 689-1201, Japan

said non-signing inventor who could not be reached or found.

(6) In attempting to reach or find Mr. Yakura, Mochigase exerted considerable efforts to do so. However, apparently the reason why Mr. Yakura failed to cooperated with Mochigase to obtain his signature on the application documents is that Mochigase previously had filed a criminal complaint against Mr. Yakura for breach of trust sometime in December 2003.

(7) The criminal complaint filed against Mr. Yakura by Mochigase was pursuant to the provisions of Chapter 37, Article 247 of the Japanese Penal Code, which provides, to wit:

When a person who is in charge of the affairs of another, for the purpose of promoting his/her own interest or the interest of a third party, or inflicting damage on another, commits an act in breach of legal duty and causes financial loss to another, imprisonment with work for not more than 5 years or a fine of not more than 500,000 yen shall be imposed

(8) Mochigase based the criminal complaint against Mr. Yakura on the following facts:

(a) Mr. Yakura assumed the director of a company named Kobo Construction Company ("Kobo"), deemed to be a competitor of Mochigase, as of July 25, 2003, during his tenure as an employee of Mochigase.

(b) Mochigase believes that before the publication of International Application No. PCT/JP2004/010385 (the corresponding PCT application of the U.S. application), Mr. Yakura offered and supplied the technological information pertaining to the subject invention to Kobo, without the knowledge or approval of his employer Mochigase. In so doing, Mochigase believed that Mr. Yakura thereby misappropriated the fruits of Mochigase's research and development endeavors.

(c) When Mochigase learned about the transfer of technological information to Kobo, Mr. Yakura was subjected to disciplinary action by Mochigase and consequently was given his dismissal papers on December 12, 2003.

(d) Mochigase also believes that after his dismissal from employment at Mochigase, Mr. Yakura, together with some colleagues, caused the dissemination of lies and wrongful information about the Mochigase, such as its impending bankruptcy.

(9) Mochigase thus filed a criminal complaint before the Tottori Police Headquarters against Mr. Yakura sometime in December 2003, since his last known address is located in Tottori-ken (Province).

(10) The above circumstances could explain why Mr. Yakura appears to have ignored all efforts made by Mochigase to obtain his cooperation in executing the deed of assignment and Declaration.

(11) Accompanying this Declaration is:

(a) Certification from the police of Tottori Japan that Mochigase Electrical Equipment Co., Ltd. filed a criminal Complaint against Mr. Masami Yakura, the non-signing inventor, and

(b) A translation of the Complaint of 5(a) as filed.

The undersigned declares that all statements made herein of my own knowledge are true and that the statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code and that such willful statements may jeopardize the validity of the application or document or any registration resulting therefrom.

Dated: December 3, 2007

—

Docket No. 060131

By: Kazuo Wakabayashi

Kazuo WAKABAYASHI



Complaint

December , 2003

To : A chief Constable of the police headquarters of Tottori Prefecture Police

Accuser agent of Mochigase Electrical Equipment Co., Ltd.
Attorney at law Takenobu Kawamura

7-2 Mochigase, Mochigase-cho, Tottori-shi, Tottori 689-1201, Japan

Accuser, Mochigase Electrical Equipment Co., Ltd.

Representative Director representative Kazuo Wakabayash

13-3 Takahashi North 3 Bldg., Kita-ku, Osaka-shi, 530-0047, Japan

Kawamura Takenobu · Nishi akira Law office(Place of service)

Accuser agent,

Attorney at law Takenobu Kawamura

91 Nishihonji, Mochigase-cho, Tottori-shi, Tottori 680-0811, Japan

Accused, Masami Yakura

1-14 Minamiasahigaoka 6-choume, Ibaraki-shi, Osaka, 567-0046, Japan

Accused, Hiroshi Saito

A purpose/purposes of the accusation

Because the accused fall under breach of trust, the provisions Chapter 37, breach of trust Article 247 of the Japanese Penal Code, I request Accused severely, after the investigation zealously.

A fact/facts of the accusation

1. Complainant

(1) Accuser, Mochigase Electrical Equipment Co., Ltd. (hereinafter referred to as THE COMPANY or MOCHIGASE ELECTRICAL EQUIPMENT) with its principal office at the address written in the title of complainant was founded in August, 1975, is capitalizes at 26 million yen, has 76 employees and is the company setting up Takano factory(Yazu-cho, Tottori Prefecture) and a development center(Izumi-shi, Osaka Prefecture). The business contents are the winding processing of the compressor motors such as an air-conditioner/a refrigerator/the dehumidifier, development, production and sale of dioxin suppressant "DXNON"(Trademark of the company) ,and, production and sale of antibacterial agent "Barriere"(Trademark of the company).

(2) Accused, Masami Yakura entered MOCHIGASE ELECTRICAL EQUIPMENT in

August, 2002, is assigned to the research and development room which started in 1994 in inter, and it is the working staff and holds the position of the researcher Chairman of the company research and development room. And He is the central member of the research and development team which researched and developed "BR-P" (Product name: antibacterial agent "Barriere" (Trademark of the company) co-developed with Professor Koichi Otsuki, the department of agriculture of the Tottori University since April, 1988.

(3) Accused, Hiroshi Saito is Representative Director of Kenchiku Koubo, Co., Ltd.. And Kenchiku Koubo, Co., Ltd. runs ① the investigation(s) of buildings in an area/areas and a city/cities, a plan/plans and a design /designs and management(s), ② a plan/plans, a development / developments, a fundamental research/ fundamental researches of the material(s) / the product(s) about the environment, ③ an enlargement / enlargements of sale plan(s) about the spread of environmental articles which Kenchiku Koubo, Co., Ltd. participated in, ④ a plan /plans, an advertisement /advertisements, an advertising and guidance/ advertisings and guidance, ⑤ the publication of results of research and ⑥ all duties to accompany as above. And Kenchiku Koubo, Co., Ltd. receives Accused, Masami Yakura to the director of Kenchiku Koubo, Co., Ltd. on July 25, 2003.

In addition, Accused, Masami Yakura becomes the inspector of SK corporation established on November 11, 2003 Ltd..

2. A malpractice/ malpractices

It goes without saying that Accused, Masami Yakura is an employee employed by MOCHIGASE ELECTRICAL EQUIPMENT. Therefore, Accused, Masami Yakura bears faithful duty in work contract for MOCHIGASE ELECTRICAL EQUIPMENT. Concretely,

① Accused, Masami Yakura must not leak an on-the-job serious secret to the third party(s) outside THE COMPANY,

② In October, 2003, in a nerve center of MOCHIGASE ELECTRICAL EQUIPMENT, there was recognition that it was the trade secret information for MOCHIGASE ELECTRICAL EQUIPMENT that MOCHIGASE ELECTRICAL EQUIPMENT was planning to ship a sample/samples for sale purposes) of the "Barriere" (Trademark of THE COMPANY) mist spray, to file a patent application/patent applications about the invention of "Barriere" (Trademark of THE COMPANY) mist spray to JPPTO and to treat "Barriere" (Trademark of THE COMPANY) mist spray as a strategic article of MOCHIGASE ELECTRICAL EQUIPMENT. And MOCHIGASE ELECTRICAL EQUIPMENT forbade disclosing such an information to the third party/parties till

there were special instructions. However, Accused, Masami Yakura offered A. mentioned below for the purpose of planning the profit of Accused, Hiroshi Saito who was the third party for MOCHIGASE ELECTRICAL EQUIPMENT (and is complicity relationship with Accused, Masami Yakura), betrayed faithfulness duty in work contract for MOCHIGASE ELECTRICAL EQUIPMENT by doing the acts to show in B mentioned below.

A. In October, 2003, Accused, Masami Yakura offered such information as the antibacterial deodorization new material called "Barriere" (Trademark of THE COMPANY) is the new material which reduces SARS virus, the chief ingredient of the new material is with calcium and magnesium, which comes from a certain natural mineral, dolomite with high safety, which was press released by Tottori University after Tottori University received mass communication about the new material, which was effective material from the both sides with hygiene side and the bad smell side, which was with an immediate effect and which was the new material that the broad use is possible in a medical field and field of care other life-related field, and in addition, Accused, Masami Yakura offered the samples (several samples) of the "Barriere" (Trademark of THE COMPANY) mist spray to Accused, Hiroshi Saito in order that a kind syndicate, "SOKEN" exhibited and advertised "Barriere" mist spray in an exhibition, "Venture EXPO 2003" which was held in Osaka international convention facility for from 25 to 26 on November in 2003 through both Kenchiku Koubo, Co., Ltd. run by Accused, Hiroshi Saito and SK corporation.

B. In October, 2003, Accused, Masami Yakura betrayed faithfulness duty in work contract for MOCHIGASE ELECTRICAL EQUIPMENT by taking office as the director of Kenchiku Koubo, Co., Ltd. in order to sell the same product which was co-developed with both MOCHIGASE ELECTRICAL EQUIPMENT and Tottori University, filed the patent application on August, 12, 2003 and called "BR-P" (Trademark of THE COMPANY) (PRODUCT NAME: "Barriere" (Trademark of THE COMPANY) under Trade mark "DEPLOT" and by proposing an agency contract with a kind syndicate, "SOKEN" (① Sale of the garbage processing machine, ② A contract/contracts of the maintenance of facilities, ③ all duties to accompany as above, Director representative Eiki Nagatani) for the purpose of planning the profit of Kenchiku Koubo, Co., Ltd. run by Accused, Hiroshi Saito with that in mind.

The circumstances

1. It is a vicious act that Accused, Masami Yakura et.al. seize the result that another person finally got by a study and development for the many years of another person concerned by force. Such an act must not be overlooked by any means, if such act is left to start, such act will cause a social loss such as disturbance of both the development of a product/products which is/are superior, useful and produced as a result of earnest effort of a study and the commodification of such a product/products.

2. In particular, Accused, Masami Yakura is a researcher owning industrial properties such as patents about the invention that Accused, Masami Yakura oneself invented in former work. Accused, Masami Yakura can imagine research funds and the development cost that are a big sum and is in a position to be able to grasp it, since he entered MOCHIGASE ELECTRICAL EQUIPMENT. He knows that the study/studies performed in Tottori University was/were a great patient effort/ great patient efforts well. It is a crime for Accused, Masami Yakura to seize such a result/results by force when the effort of many years bears fruit for MOCHIGASE ELECTRICAL EQUIPMENT, and such an act must not be forgiven.

3. In addition, there is a thing concerned for THE COMPANY. THE COMPANY did disciplinary dismissal of Accused, Masami Yakura on December 12, 2003 because he was trusted by the president Kazuo Wakabayashi, et.al.and, and, as a result, he had strong influence in in the office, in particular the laboratory of THE COMPANY.

In addition, as a problem of THE COMPANY, a fellow worker/fellow workers conspired with Accused, Masami Yakura and there is injustice / the fact that such a fellow worker/fellow workers repeated an unfair act. If THE COMPANY does not remove these pollution parts, the administration of THE COMPANY may become impossible, in order that THE COMPANY is planning to plan normal administration in the future. Accuser demands a severe step for Accused, because, assuming such a situation, Accused may spread a false rumor to go bankrupt in THE COMPANY, and, may do a project of this take-over.

A charge and a punishment article

Breach of trust

criminal law Article 247

criminal law Article 60

Attached documents

- 1. A company commerce register certified copy(MOCHIGASE ELECTRICAL EQUIPMENT)**
- 2. A copy of the profile of MOCHIGASE ELECTRICAL EQUIPMENT**
- 3. A copy of the patent application(reserve)**
- 4. A copy of the documents of the introduction of an antivirus agent, "Barriere" (Trademark of THE COMPANY), and "BR - P3" (Trademark of THE COMPANY)**
- 5. A copy of the e-mail magazine delivered by the economy industry station of China district of Japan (The 162nd, delivered on October 6,2003)**
- 6. A copy of the advertising thing advertised by a kind syndicate, "SOKEN" in VENTURE EXPO 2003 and one display exhibited a kind syndicate, "SOKEN" in VENTURE EXPO 2003**
- 7. A company commerce register certified copy(Kenchiku Koubo, Co., Ltd.)**
- 8. A company commerce register certified copy(SK Co., Ltd.)**
- 9. A company commerce register certified copy(a kind syndicate, "SOKEN")**

Dear sirs

I enclosed herewith a copy of complaint. Normally, I should bring such copy and explain the situation in detail. I hate to mention it, but I would like you to receive such copy of complaint sent by mail and cope with the case written in the copy of complaint, since this matter is of some urgency because the accused act criminal activities diligently.

I will visit the police headquarters of Tottori Prefectural Police in person, interview a person in charge of this matter in the investigating authority and offer one of the products enclosed as attached document 6 in near future.

I will visit a person in charge of such work assignment of Tottori Prefectural Police in person on a date when the copy of complaint might reach the police headquarters of Tottori Prefectural Police.

Thank you in advance for taking care of this matter.

Sincerely,

December 17, 2003

Accuser agent of Mochigase Electrical Equipment Co., Ltd.

Attorney at law, Takenobu Kawamura

To : Mr. Shinrou Sasaki, a Chief Constable of the police headquarters of
Tottori Prefectural Police